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EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary

Application No.

09/588,280

Applicant(s)

KHORRAM, RAMIN

Examiner

Charles Appiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, 4, 5, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by **Davani (6,208,839)**.

Regarding claim 1, Davani discloses a method of using a storage module in a device comprising: receiving data in response to a request sent by the device (feature of paging system accepting page or message requests from several external sources . . . and paging terminal encoding and transmitting selective call message comprising a selective call address and possibly canned message to selective call receiver, col. 2, lines 19-66), identifying an automatically substituted code in the data (if message is a canned message, e.g., one commonly referred to as a predetermined, pre-stored, or programmable message, or token representing a canned message, col. 5, line 49 to col. 6, line 15), replacing the code in the data with corresponding terms in the storage module prior to displaying the data (feature of personal messaging device selectively formatting the retrieved information to take the best advantage of the information display capability of the personal messaging device, col. 6, lines 15-26, col. 7, lines 38-45).

Regarding claim 2, Davani further shows (inherently) periodically updating the data in the storage module (feature of notifying a user of recent additions by highlighting new urls with the word "NEW", col. 7, lines 18-32).

Regarding claim 4, Davani further shows wherein a term may comprise one or more of the following: a word, a phrase, a graphic element, an image, graphic animation sequence, video clip, sound clip, applet, or BLOB (canned message comprising singly or in combination a textual representation of the displayed text annotating the url, col. 7, lines 32-45).

Regarding claim 5, Davani's teaching of displaying a list of canned messages and associated tokens (col. 8, lines 1-27), read on the feature of storing a plurality of code-term pairs in the storage module and inserting the storage module into the device.

Regarding claim 6, Davani's teaching of sending a canned message corresponding with a selected bookmark (col. 7, lines 38-45) as well as presenting the information with the result of the most efficient use of broadcast airtime by reducing the amount of data that needs to be sent to the personal messaging device (see col. 8, lines 51-58) meets data being received in the device over a low bandwidth wireless connection.

Regarding claim 7, Davani further teaches wherein the storage module is a device selected from among the following: a Flash memory, a Klik! Disk, an EEPROM, a magnetic storage device, an IBM MicroDrive, an optical storage device (see col. 6, lines 34-39).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Davani (6,208,839)**.

Regarding claim 3, Davani meets all limitations as applied above to claim 1. In addition Davani further shows periodically updating the data in the storage module (feature of notifying a user of recent additions by highlighting new urls with the word "NEW", col. 7, lines 18-32), but fails to explicitly teach periodically replacing the storage module in the device to contain an often-used set of terms.

However, since it is well known in the art that storage in portable communication devices are very limited and since Davani shows periodically notifying a user of recent additions, it would have been obvious to one of ordinary skill in the art to ensure the availability of often used terms in the storage module in order to properly use available storage resources by reducing the amount of data that needs to be updated.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Davani** as applied to claim 1 above, and further in view of **Pinter (5,894,506)**.

Regarding claim 23, Davani further shows notifying a user of recent additions by highlighting new urls with the word "NEW", col. 7, lines 18-32. Davani fails to teach updating the storage module by using a higher bandwidth connection, as selected from among the following: a wireless connection, a docking station based connection, an infrared connection and a direct connection to a network.

Pinter discloses an electronic messaging system that includes the feature of periodically updating a database using a high bandwidth connection such as a wireless connection (see Fig. 6, col. 7, lines 23-54).

It would therefore have been obvious to one of ordinary skill in the art to provide for the updating of stored information including canned messages wirelessly as taught by Pinter in Davani's system in order to use communication resources more efficiently.

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Davani** as applied to claim 1, above, and further in view of **Schroeder et al.** (6,405,060).

Regarding claims 8 and 9 Davani fails to teach the feature of a statistic gathering logic for gathering statistics about the frequency of occurrence of each code and of each term in the storage module and the data respectively and transmitting the statistics for updating contents of the storage module or identifying which codes are used.

Schroeder discloses an improved user interface for a cellular telephone system with several functions including a predictive keyboard capable of inputting and displaying to a user the most commonly used characters for selected words in a particular language (see col. 1, lines 40-59), including the use of statistical analysis of sample text to determine characters for display (see col. 5, lines 19-45). Schroeder teaches an embodiment in which a user is allowed to enter a list of words that the user frequently uses in messages and also build a character frequency table from the set of

words or the phone comes a pre-defined set of character frequencies which may be modified by analyzing the character frequencies of messages entered by a user over time so that the table of frequencies automatically adapts to the types of words used by the user (see col. 5, lines 46-55), which suggests the capability of statistics gathering for modification or updating purposes as desired.

It would therefore have been obvious to one of ordinary skill in the art to combine Schroeder's teaching of statistical analysis with the system of Davani in order to use statistical analysis for providing identification and/or updating or modification of stored data or information such as codes on an as needed basis.

8. Claims 10, 14, 15, 16, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe et al. (5,673,322)** in view of **Pinter (5,894,506)**.

Regarding claim 10, Pepe discloses a service provider for providing data to a device and a portable device (52) having a low bandwidth connection to a network to receive formatted Web content in response to a request (see Fig. 2, col. 7, lines 10-44), the service provider including a database (inherent in WWW (Internet 68, remote proxy 66) and formatting logic to retrieve data in response to a request from the device (see col. 5, line 46 to col. 6, line 29) and transmission logic to transmit the data to the device (see col. 8, lines 6-16). Pepe further teaches the capability of a laptop computer or PDA to have direct access to the WWW from a mobile (wireless) terminal (col. 6, lines 65-67), and that protocol translations are carried out between the local proxy in the user terminal and the remote proxy in order to allow standard web browsers to support low band-width web browsing (see col. 7, lines 15-44).

Pepe fails to teach that the service provider explicitly includes a database having a plurality of codes and associated terms, and substitution logic to automatically replace a term in a data with a code and transmitting the data including the code to the device.

Pinter discloses a method and apparatus for generating and communicating messages between subscribers in an electronic messaging network that include a service provide for providing data via low bandwidth connection (feature transmitting message (code or text) to terminal (step 58), the service provider including a database having a plurality of codes and associated terms (NOC maintaining multiple files of canned messages and canned response options, including files identical to those stored at calling terminal and possibly also at receiving terminal, col. 6, lines 3-6), a substitution logic to replace a term in the data with a code (step 56 through "code" to step 58), a transmission logic to transmit the data including the code (step 58), see Figure 3.

It would therefore have been obvious to one of ordinary skill in the art to combine the above teaching of Pinter by selecting and transmitting canned messages and codes with the system of Pepe in order to ensure the conservation communication link capacity with efficient available spectrum utilization while making information over the world wide web available to desiring subscribers.

Regarding claim 14, the combination of Pepe and Pinter shows (as taught by Pinter) that data in the database is periodically updated (steps 100-108, Figure 6, col. 7, lines 23-54).

Regarding claim 15, Pepe discloses a portable device (52) capable of having a low bandwidth connection to a network to receive formatted Web content in response to a request see col. 5, line 46 to col. 6, line 29). Pepe further teaches the capability of a laptop computer or PDA to have direct access to the WWW from a mobile (wireless) terminal with the mobile terminal inherently having a storage module (col. 6, lines 65-67), and that protocol translations are carried out between the local proxy in the user terminal and the remote proxy in order to allow standard web browsers to support low band-width web browsing (see col. 7, lines 15-44), which read on the feature of the bandwidth of data transferred over the low bandwidth connection being reduced. Pepe fails to teach the portable device having a plurality of codes and associated terms in the storage module, and substitution logic to automatically replace a term in a data with a code and transmitting the data including the code to the device in order to reduce to the bandwidth of the connection by transmitting the codes instead of the associated data.

Pinter discloses a method and apparatus for generating and communicating messages between subscribers in an electronic messaging network that include a service provide for providing data via low bandwidth connection (feature transmitting message (code or text) to terminal (step 58), the service provider including a database having a plurality of codes and associated terms (NOC maintaining multiple files of canned messages and canned response options, including files identical to those stored at calling terminal and possibly also at receiving terminal, col. 6, lines 3-6). Pinter's fig. 4 further shows a terminal receiving a message from NOC 1), identifying a code in the data (step 72 to 76), replacing the code in the data with corresponding terms in the

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storage module (retrieve message and response options text, step 76, see col. 6, lines 33-38), prior to displaying the data (display message and response options text, step 74, col. 6, lines 38-41).

It would therefore have been obvious to one of ordinary skill in the art to combine the above teaching of Pinter by selecting and transmitting canned messages and codes with the system of Pepe in order to ensure the conservation communication link capacity with efficient available spectrum utilization while making information over the world wide web available to desiring subscribers.

Regarding claim 16, Pepe's Fig. 2, shows that the low bandwidth connection is a wireless connection.

Regarding claim 17, the combination of Pepe and Pinter would show that the storage module is a built in device as taught by Pinter (RAM being built into the portable device and NOC, see Figs. 7 and 8).

Claim 22 is rejected for the same reasons as set forth in the rejection of claims 10 and 15 above. In addition Pepe's Web browser 52 of Fig. 2 meets displaying data on the device.

9. Claims 11-13, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe et al and Pinter** as applied to claims 10 and 15 above, and further in view of **Schroeder et al. (6,405,060)**.

Regarding claims 11 and 20, the combination of Pepe and Pinter fail to teach statistic gathering logic for gathering statistics about the frequency of occurrence of each code and of each term in the storage module and the data respectively and

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transmitting the statistics for updating contents of the storage module or identifying which codes are used.

Schroeder discloses an improved user interface for a cellular telephone system with several functions including a predictive keyboard capable of inputting and displaying to a user the most commonly used characters for selected words in a particular language (see col. 1, lines 40-59), including the use of statistical analysis of sample text to determine characters for display (see col. 5, lines 19-45). Schroeder teaches an embodiment in which a user is allowed to enter a list of words that the user frequently uses in messages and also build a character frequency table from the set of words or the phone comes a pre-defined set of character frequencies which may be modified by analyzing the character frequencies of messages entered by a user over time so that the table of frequencies automatically adapts to the types of words used by the user (see col. 5, lines 46-55), which suggests the capability of statistics gathering for modification or updating purposes as desired.

It would therefore have been obvious to one of ordinary skill in the art to combine Schroeder's teaching of statistical analysis with the system of Pepe as modified by Pinter in order to use statistical analysis for providing identification and/or updating or modification of stored data or information such as codes on an as needed basis.

Regarding claim 12, the combination of Pepe and Pinter fail to teach an analyzing logic to analyze statistics and determine a set of useful terms for inclusion in the database.

Schroeder further teaches the use of statistical on a sample text of a particular language and the capability of automatically being able to modify the table of character frequencies to adapt to the types of words used by the user (see col. 5, lines 19-55).

It would have been obvious to one of ordinary skill in the art to use the teaching of Schroeder with the system of Pepe and Pinter in order to dynamically adapt the stored data or codes to a user's preference.

Regarding claims 13 and 21, the combination of Pepe and Pinter (as taught by Pinter) suggests the capability of generating an updated data set for the database (steps 100-108, Figure 6), while Schroeder suggests statistics gathering for modification or updating purposes as desired (see col. 5, lines 19-55).

Regarding claim 24, the combination of Pepe, Pinter and Schroeder shows updating the storage module by using a higher bandwidth connection, as selected from among the following: a wireless connection, a docking station based connection, an infrared connection and a direct connection to a network as taught by Pinter (see Fig. 6, col. 7, lines 23-54).

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe et al** and **Pinter** as applied to claim 15 above, and further in view of **Kovanen et al. (5,448,765)**.

Regarding claim 18, the combination of Pepe and Pinter fail to specifically teach that the storage module is a removable device.

The use of removable storage devices in portable electronic devices such as a radio telephone is very well known in the art as taught for example by Kovanen.

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Kovanen discloses a radio (e.g. a radiotelephone having a removable memory means for (see abstract). According to Kovanen, the use of the removable memory means facilitates the updating of the radiotelephone with new functions or tailored accordance with the special requirements of the user or the system (see col. 2, lines 25-41). By configuring the radiotelephone with at least on a system-specific basis the control parameters the user is able to change radio systems in an easy and reliable manner and facilitates the use of an existing radiotelephone in other radiotelephone systems and that switching on the removable memory enables easy updating of software of a radio telephone (see col. 2, lines 42-67) and in which the removable memory can be any removable memory suited for the purpose depending on the storage capacity needed such as SRAM modules (see col. 3, line 57 to col. 4, line 7).

It would therefore have been obvious to one of ordinary skill in the art, to use the above teaching of Kovanen by using a removable memory means with the system of Pepe and Pinter for the benefit of being able to provide easy updating of the telephone with new functions and information as desired, based on storage capacity needs

Regarding claim 19, the combination of Pepe and Pinter (as taught by Pinter further discloses the storage means as being a RAM (114, see Figure 7). Pepe as modified by Pinter fail to teach that the storage device is selected from among the following a flash memory, a Klik!, an EEPROM, a magnetic storage device, an IBM MicroDrive and an optical storage device (RAM, 114, Figure 7).

Kovanen teaches a radio (e.g. a radiotelephone having a removable memory means for (see abstract), in which the removable memory can be any removable memory suited for the purpose depending on the storage capacity needed such as SRAM modules (see col. 3, line 57 to col. 4, line 7).

It would therefore have been obvious to one of ordinary skill in the art, to use the above teaching of Kovanen by using any removable memory means with the system of Pepe and Pinter for the benefit of being able to provide easy updating of the telephone with new functions and information as desired, based on storage capacity needs of the user.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703 305-6739. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703 308-6296 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306-0377.

CA
March 10, 2003


CHARLES APPIAH
PATENT EXAMINER (PRIMARY)